



AF/3722 #

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March 5, 2004
Date

Joanne Bourguignon

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ted Eugene Wright
Application No.: 09/499,069
Filed: February 4, 2000
Title: SINGLE-SHEET REGISTRATION FORM AND KEY PACKET

Examiner: Monica Smith Carter
Art Unit: 3722
Docket No.: 35008.001
Date: March 5, 2004

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APPEAL BRIEF TRANSMITTAL

Sir:

Transmitted herewith, in triplicate, is the Appeal Brief in this application, with respect to the Notice of Appeal filed on January 5, 2004. The Commissioner is hereby authorized to charge the fee of \$320 for filing this Appeal Brief to Deposit Account No. 50-2976.

The Commissioner is hereby authorized to charge any fees in conjunction with this communication or to credit any overpayment to Deposit Account No. 50-2976. This notice is being submitted in duplicate.

Respectfully submitted,
Ted Eugene Wright
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Inventors: Ted Eugene Wright

Serial No. 09/499,069

Filed: February 4, 2000

For: SINGLE-SHEET REGISTRATION FORM AND KEY PACKET

Examiner: Monica Smith Carter

Group Art Unit: 3722

Docket No. 35008.001

Date: March 5, 2004

BRIEF ON APPEAL

Commissioner of Patents and Trademarks
Washington, DC 20231

Sir:

This appeal is from the decision of the Examiner, in an Office Action mailed on October, 06, 2003, rejecting claims 1-7 and 11-21 of U.S. Application No. 09/499,069 ("current application").

REAL PARTY IN INTEREST

Electronic Forms Plus, Inc., is the Assignee of the present patent application. Electronic Forms Plus, Inc., is a California corporation with headquarters in San Diego, California.

RELATED APPEALS AND INTERFERENCES

Applicant's representative has not identified, and does not know of, any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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STATUS OF CLAIMS

Claims 1-7 and 11-21 are pending in the current application. Claims 1-7 and 11-21 were rejected in the Office Action dated October, 06, 2003. Applicant appeals the rejection of claims 1-7 and 11-21, which are copied in the attached Appendix I.

STATUS OF AMENDMENTS

An Amendment is enclosed with this brief. Amendments have been made to two claims to correct two typographical errors noted by the Examiner in the Office Action mailed on October, 06, 2003, and to place the claims into proper form for the Appeal.

SUMMARY OF INVENTION

The claimed invention is a single-sheet registration form and key packet intended for use in hotels, motels, and other such businesses in which guests or customers are registered and provided with keys. The single-sheet registration form and key packet is preprinted with general information. At the time that a guest or customer is registered, a clerk may obtain registration information from the guest, type that information into a form displayed by a computer, and print the information, or a subset of the information, onto the single-sheet registration form and key packet via a laser printer or other printing device interconnected with the computer, to produce a completed registration form and key packet. The computer uses knowledge of the format of preprinted information in order to print additional information related to a particular guest or time sensitive information onto the preprinted single-sheet registration form and key packet. The clerk, in one step, separates the registration form from the key packet along a line of perforations, and provides the registration form for the guest's signature. The clerk then quickly assembles the key packet in two steps by folding along two lines of perforations, inserts one or more room keys into slots dye-cut into the key packet, and hands the assembled key packet to the guest.

Figure 2 of the current application shows a single-sheet-registration-form-and-key-packet blank, prior to initial printing. The single-sheet-registration-form-and-key-packet blank includes a perforated, vertical fold line, a horizontal line of perforations 204 separating the registration form 206 from the key packet 208, a horizontal perforated fold line 210, and dye-cut slots 212 and 214 for a magnetic key card and metal key, respectively. Figure 3 of the current application shows the single-sheet registration form and key packet following

initial printing – commonly offset printing – to produce a preprinted single-sheet-registration-form-and-key-packet form. Preprinted single-sheet-registration-form-and-key-packet forms are loaded into a printer interconnected with a desk computer, and are printed with particular guest information and time-sensitive information, as shown in Figure 4 of the current application. The registration form is separated from the key packet, as shown in Figure 5 of the current application. The key packet is then folded along the horizontal, perforated fold line, as shown in Figure 6 of the current application, and then folded along the vertical, perforated fold line to produce the completed key packet, as shown in Figure 8 of the current application.

Example preprinted single-sheet-registration-form-and-key-packet forms were provided, in Exhibit D, in an Amendment filed on August 5, 2002, to provide definitive illustration of the claimed invention.

ISSUES

1. Whether the Examiner can reject claims directed to Applicant's registration form and key packet under 35 U.S.C. § 103(a) when an extensive declaration accompanied by evidence for commercial success, copying by others, and attempts by customers to remove the "Patent Pending" notice from Applicant's claimed registration form and key packet have been twice submitted by Applicant with extensive explanation, and yet have been neither substantively responded to, nor apparently substantively considered, by the Examiner.
2. Whether a reference that discloses a decidedly non-rectangular airline ticket envelope manufactured from two separate pieces of dissimilar materials in numerous steps involving application of adhesives can serve as the basis for either a 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) rejection of claims directed to a rectangular, single-sheet registration form and key packet that can be quickly and accurately folded into a complete key packet in two or fewer steps.
3. Whether the claimed rectangular, single-sheet registration form and key packet is anticipated under 35 U.S.C. § 102(b) by Thompson, U.S. Patent No. 3,655,119.
4. Whether the claimed rectangular, single-sheet registration form and key packet is

made obvious, under 35 U.S.C. § 103(a), by Thompson, U.S. Patent No. 3,655,119, alone or in combination with Crowell, U.S. Patent No. 4,592,573.

GROUPING OF CLAIMS

Because each of the appealed independent claims 1, 11 and 16 present different facets of the present invention, and because each of the dependent claims introduce additional elements or qualifications, no grouping of the claims naturally appears that requires claims as a group to stand or fall together. Therefore, each of the appealed claims must be considered separately.

ARGUMENT

Claims 1-21 are currently pending in the application. In an Office Action dated October 6, 2003 ("Most Recent Office Action"), the Examiner rejected claims 1 and 7 under 35 U.S.C. § 102(b) as being anticipated by Thompson, U.S. Patent No. 3,655,119 ("Thompson"), rejected claims 2 and 5 under U.S.C. § 103(a) as being unpatentable over Thompson, and rejected claims 3, 4, and 11-21 under 35 U.S.C. § 103(a) as being unpatentable over Thompson in view of Crowell, U.S. Patent No. 4,592,573 ("Crowell"). Applicants respectfully disagree with these rejections

Issue 1

1. Whether the Examiner can reject claims directed to Applicant's registration form and key packet under 35 U.S.C. § 103(a) when an extensive declaration accompanied by evidence for commercial success, copying by others, and attempts by customers to remove the "Patent Pending" notice from Applicant's claimed registration form and key packet have been twice submitted by Applicant with extensive explanation, and yet have been neither substantively responded to, nor apparently substantively considered, by the Examiner.

In an Amendment filed on August 5, 2002, Applicant included a Declaration and evidence, in Exhibits A-C, in support of a number of secondary considerations of nonobviousness. Applicant's representative included the following statement, beginning on line 19 of page 5 of the Amendment:

The Examiner has not yet responded to these noted facts, which Applicant's representative believes are strong evidence of the nonobviousness of Applicant's claimed invention. Applicant's representative therefore has provided, in the Current Response, a signed Affidavit, accompanied by four Exhibits, from the Applicant stating: (1) that Applicant has achieved ever-increasing retail sales volume for single-sheet registration forms and key packets, as claimed by Applicant; (2) that Applicant's single-sheet registration forms and key packets have been copied and advertised for sale by competitors; (3) that a subsidiary of one of Applicant's customers has attempted to force Applicant to remove the "Patent Pending" notice from Applicant's products, to enable the subsidiary to offer Applicant's competitors a chance to bid on producing products that would infringe Applicant's claimed invention; and (4) that Applicant invented the single-sheet registration forms and key packets as a result of the convergence of careful observations of prior systems and techniques, experience in electronic forms production, the advent of commercially viable laser printers, and a significant development and experimentation effort.

As noted in the MPEP § 2144.08 (II)(B), "Office Personnel should consider all rebuttal arguments and evidence presented by applicants. ... Rebuttal evidence may include evidence of 'secondary considerations,' such as 'commercial success, long felt but unsolved needs, [and] failure of others.' ... Rebuttal evidence may include evidence that the claimed invention was copied by others." Applicant's representative respectfully requests the Examiner to enter the supplied Affidavit and evidence into the record, and to consider the supplied evidence with regard to the Examiner's obviousness-type rejections.

In an Office Action dated August 27, 2002, the Examiner rejected the Declaration and supporting evidence because, as stated by the Examiner in Section 2, page 2 of the Office Action, "It refer(s) only to the system described in the above referenced application and not to the individual claims of the application." In a subsequent Response, Applicant's representative responded:

1.132 Declaration

First, with regard to the 1.132 Declaration, Applicant's representative finds perplexing the Examiner's stated reasons for finding the declaration insufficient. The Examiner refers to a lack of showing that the objective evidence of nonobviousness is commensurate in scope with the claims. This statement appears to refer to Section 716.02(d) of the MPEP, which deals with evidence presented to support a claim of unexpected results. This section deals with chemical inventions, in which a range of physical of some state value, such as temperature, is claimed. In such cases, unexpected results must be shown for the entire claimed range of the state value. This would appear to be an entirely reasonable proposition, but this proposition and the MPEP section in which it is put forth, have absolutely nothing to do with Applicant's claimed single-sheet registration form and key packet. Applicant does not claim a range of temperature, pressure, or chemical composition. The 1.132 Declaration, as originally filed, stated:

Submitted herewith are statements of fact and documentation that demonstrate that my clearly claimed SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, the subject of U.S. Patent Application No. 09/499,069 and a Continuing Prosecution Application is non-obvious in light of the references cited by the Examiner, and arguments made by the Examiner, during prosecution of U.S. Patent Application No. 09/499,06.

The current application contains two independent claims, both claiming "[a] single-sheet registration form and key packet," and the term "single-sheet registration form and key

packet" is capitalized in the above-quoted statement as it is throughout the originally filed 1.132 Declaration. Moreover, the evidence that accompanied the 1.132 Declaration clearly showed the claimed invention, included embodiments of the claimed invention, and included textual materials that clearly refer to a "registration form and key packet."

In an Office Action dated February 21, 2003, the Examiner responded, in Section 7 beginning on page 8, by quoting from MPEP § 716 and including a statement on page 11, quoted below in Applicants' representative's Response, in an Amendment filed May 23, 2003:

1.132 Declaration

Applicant's representative finds the Examiner's statements regarding the 1.132 Declaration confusing. The Examiner states that the 1.132 Declaration "refer(s) only to the system described in the above referenced application and not to the individual claims of the application. As such the declaration does not show the objective evidence of nonobviousness is commensurate in scope with the claims." The Examiner subsequently reproduces a lengthy portion of MPEP § 716, along with paragraph 7.66.03 from which the Examiner extracted the above-quoted language. The Examiner then states:

This declaration is directed to how the invention was reduced to practice and the continued diligence of the invention and not to how the claims are nonobvious over the cited references. The submitted correspondence, purchase orders, sample forms and other materials fail to distinguish the claimed invention from the references upon which the rejections are based. The provided material dates back to the summer of 1998. The references used in the rejections were patented more than one year prior to the filing of the provisional patent application (May 20, 1999). Therefore, the examiner maintains that the declaration is insufficient to overcome the rejections of record.

These statements appear to represent a rather fundamental misreading of Applicant's declaration. First, there is not one instance of the word "system" in Applicant's declaration. In fact, Applicant has not claimed a system, but has instead claimed, in independent claims 1 and 11, a "single-sheet registration form and key packet." Moreover, this is not an overly complex invention, and certainly one that can be understood without even a technical background. Second, the 1.132 Declaration clearly and unambiguously refers to the "SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15," in 20 different places, and not once refers to a "system described in the above referenced application." Moreover, unlike in more complex technical and scientific areas, the current claim set does not include groups of claims directed to methods, groups of claims directed to systems, and groups of claims directed to computer-readable media containing program instructions. Instead, the claims are specifically directed to an easily understood, well described single-sheet registration form and key packet, and the evidence commensurate with the scope of the claims is quite simply and easily obtained by reading the current claims and then inspecting the evidence. Third, MPEP § 716 includes, following paragraph 7.66.03, the following Examiner Note: "2.

A full explanation must be provided, if appropriate." Applicant's representative can find no explanation for the reference to paragraph 7.66.03 in the above-quoted statement that follows the reference. Applicant's representative believes that such an explanation is warranted, in view of the seeming inapplicability of paragraph 7.66.03 to the 1.132 Declaration.

These statements also appear to indicate a rather fundamental misunderstanding, on the part of the Examiner, of the purpose for, and legal basis of, the evidence of nonobviousness provided by Applicant. In a Response filed November 27, 2002, Applicant's representative discussed the 1.132 Declaration as follows:

In Applicant's representative's opinion, Applicant's claimed invention is clearly not obvious in light of any single reference, or combination of references, so far cited by the Examiner with regard to the Prior Application. In the first Office Action Response filed by Applicant's representative, on February 12, 2001, Applicant's representative noted that:

[i]n MPEP § 2141, a standard of patentability that arose in the Supreme Court case *Graham v. John Deere*, 283 U.S. 1, 148 USPQ 459 (1966) is provided in detail. **This *Graham* standard includes secondary considerations such as commercial success, long felt but unsolved needs, failures of others, etc. While the current application is directed toward a relatively simple and straightforward invention, there are a number of such secondary considerations that would argue strongly against an obviousness-type rejection. First, the Applicant has, in the year following filing of the application, built a significant business manufacturing and selling the single-sheet registration form and key packet that is the subject of the current application. The Applicant is selling the single-sheet registration form and key packets to major hotel chains, including Hilton Hotels, which have recognized efficiencies and economies in using Applicant's invention during registration of hotel guests. No such single-sheet registration form and key packet was available prior to Applicant's entry into this field, and Applicant's clients have responded to Applicant's product enthusiastically. Second, Applicant has received notice from several print shops that the print shops have been contacted by third parties to produce single-sheet registration form and key packets as disclosed in the current application, but without the patent pending status included by Applicant on his products. While perhaps a simple invention, Applicant's invention is nevertheless important to Applicant, is extremely well regarded in the hotel industry, and is already a target for copying by Applicant's competitors ...**

Applicant's representative believes that background information supplied in the 1.132 Declaration also supports a long-felt need for the single-sheet registration form and key packet. The inventor recognized problems with previously used registration forms and key packets many years prior to inventing his single-sheet registration form and key packet.

The *Graham v. John Deere* secondary considerations are not intended to show "how the claims are nonobvious over the cited references," as the Examiner

seems to believe. Instead, these secondary considerations are meant to demonstrate that other indicia of nonobviousness, perhaps more objective than a subjective finding of obviousness based on a combination of references, strongly suggest that the claimed invention was in fact nonobvious, despite the subjective finding based on a theoretical or speculative combination of references. The Examiner herself stated, at the beginning of page 13 in the Office Action, that "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." The *Graham v. John Deere* secondary considerations are, in essence, objective evidence that may, in certain cases, show that, in fact, a given judgment of obviousness based on hindsight reconstruction does not comport with objective evidence to the contrary. For example, objective evidence that an invention found broad commercial acceptance, or that an invention was subsequently copied by others, suggests that, despite whatever speculative or theoretical judgment was made based on a combination of references, the invention truly was nonobvious; otherwise, why was the claimed invention not previously produced and commercialized, and why was the claimed invention copied once it was disclosed, rather than having been made independently by others to which it was theoretically obvious? In filing the 1.132 Declaration, Applicant has provided strong evidence of both commercial success, copying, and attempts to copy Applicant's invention. Additional information provided in the 1.132 Declaration establishes a nexus between the claimed invention and the objective evidence of commercial success and copying. It was not Applicant's intention, nor is it the purpose of a 1.132 Declaration providing evidence for the *Graham v. John Deere* secondary considerations, to "distinguish the claimed invention from the references upon which the rejections are based."

In summary, Applicant's representative believes that: (1) there is no basis for invoking MPEP § 716, ¶ 7.66.03, in the current case; (2) that a full explanation of invoking MPEP § 716, ¶ 7.66.03 is required, in the current case, but not provided; and that (3) the Examiner has failed to comprehend the significance of the evidence for commercial success and copying included in the 1.132 Declaration. Again, Applicant's representative points out that, according to MPEP § 2141, "[o]bjective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, ... are relevant to the issue of obviousness and must be considered in every case in which they are present" (emphasis added).

In the Most Recent Office Action, the Examiner did not mention the Declaration or evidentiary materials supplied in Exhibits A, B, and C in the Amendment filed on August 5, 2002. The only statement in the Most Recent Office Action related to the previously supplied Declaration, evidence, and arguments is that "Applicant's arguments with respect to claims 1-7 and 11-21 have been considered but are moot in view of the new ground(s) or rejection."

Applicant's representative believes that the Declaration, evidentiary materials, and arguments with respect to the *Graham* secondary considerations are most decidedly not moot, and that these materials must be considered by the Examiner according to MPEP § 2141, and the Federal Circuit decisions cited therein. Applicant's representative believe that

the new obviousness-type rejection, largely based on a reference previously cited numerous times, is improper without consideration of, and response to, the Declaration, evidentiary materials, and arguments with respect to the *Graham* secondary considerations repeatedly offered by Applicant's representative.

Issue 2

2. Whether a reference that discloses a decidedly non-rectangular airline ticket envelope manufactured from two separate pieces of dissimilar materials in numerous steps involving application of adhesives can serve as the basis for either a 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) rejection of claims directed to a rectangular, single-sheet registration form and key packet that can be quickly and accurately folded into a complete key packet in two or fewer steps.

Thompson discloses a ticket envelope shown in Figures 1 and 2. The ticket envelope, prior to assembly, as shown in Figure 2 of Thompson, is a non-rectangular piece of paper with a protruding flap 20 and a pronounced, non-rectangular rear panel 16 protruding from a seemingly rectangular front panel 14 and closure panel 18. Thompson's ticket envelope includes "a sheet of material 44, such as glassine for example, of a generally rectangular configuration ... bonded to the inner face 24 of rear panel 16." (Thompson, column 2, lines 37-39). "The separate pocket is formed by cutting a slot in the panel which comprises one face of the usual ticket pocket and bonding a sheet of material on the inner face of such panel to provide a pocket within a pocket panel" (Thompson, column 1, lines 34-39). The protruding tab, or flap 20, is "adapted to be folded along fold line 36 into overlying relation with the bottom portion of the outer face of rear panel 16 when the latter has been folded against panel 14, and to be secured thereto by adhesive 38 to form a first pocket for receiving and retaining tickets therein" Thompson, column 2, lines 16-20). In summary, Thompson discloses a ticket envelope manufactured by bonding a glassine sheet to an irregularly shaped piece of paper, folding a rear panel onto a front panel, folding a flap onto the folded rear panel and bonding the flap with adhesive, and then folding a closing panel onto the front-panel/glassine/flap assembly.

Claim 1 of the current application, representative of the broader claims of the current application, is next provided:

1. A ***rectangular***, single-sheet registration form and key packet comprising:
 - a registration form;***
 - an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps;*** and
 - one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet. (emphasis added)

Applicant's single-sheet registration form and key packet is rectangular. Thompson's ticket envelope is quite irregularly shaped. Applicant's single-sheet registration form and key packet includes a registration form and unfolded key packet separable via a line of perforations. Thompson's ticket envelope contains no components designed to be separated from one another, and does not mention or illustrate any perforations. Applicant's single-sheet registration form and key packet includes an unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps. Thompson's ticket envelope contains no perforations, but does include three fold lines, an adhesive strip, and a separate glassine sheet that is bonded to the ticket envelope that requires at least 3 folds, two cutting operations, and two bonding operations. It is somewhat amusing to envision a hotel clerk assembling Thompson's ticket envelopes while guests queue in line at the front desk.

Thompson is simply unrelated to Applicant's claimed invention, and cannot be used, in Applicant's representative's opinion either in an anticipation rejection, or in an obviousness type rejection. As stated in MPEP § 706.02, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." As also stated in MPEP § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, and not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Thompson clearly does not qualify as an anticipating reference, as an obviousness-type reference, by itself, and could only perhaps qualify as an obviousness-type reference with

respect to teaching a slot, although Thompson's slot is shaped and sized to hold a baggage claim ticket, rather than a key, as in the claimed invention of the current application.

Issue 3

3. Whether the claimed rectangular, single-sheet registration form and key packet is anticipated under 35 U.S.C. § 102(b) by Thompson, U.S. Patent No. 3,655,119.

Clearly, as discussed with respect to Issue 2, above, Thompson does not anticipate claim 1, nor claim 7, which depends from claim 1. Thompson fails to teach, mention, or suggest a rectangular, single-sheet entity of any kind, let alone a rectangular, single-sheet registration form and key packet. Thompson fails to teach, mention, or suggest two components separable via perforations, and a key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps.

In section 3 of the Most Recent Office Action, the Examiner states:

Thompson discloses a ticket envelope (10) comprising a registration form (18); an unfolded key packet (combination of 14 and 16) separated from the registration form by a line of perforations (40), the unfolded key packet including at most two perforations (30, 36) that allow unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps (wherein the first step would be along perforation 30 and the second step would be along perforation 36) ...

However, according to Thompson: (18) is a closure panel (Thompson, column 1, line 65); (14,16) are a front panel and rear panel, respectively (Thompson, column 1, lines 64-65), that without the flap 20 and adhesive strip 38 form nothing (Thompson, column 2, lines 15-26); (30, 36, 40) are fold lines (Thompson, column 2, lines 3, 16, 28-31), and Thompson neither illustrates, mentions, nor suggests perforations of any kind; and, by simple arithmetic, Thompson's ticket envelope cannot be assembled in less than 5 discrete steps, including 3 folding steps and two bonding steps. Applicant's representative has patiently and repeatedly made these same arguments with respect to Thompson during prosecution of the current application.

Issue 4

4. Whether the claimed rectangular, single-sheet registration form and key packet is made obvious, under 35 U.S.C. § 103(a), by Thompson, U.S. Patent No. 3,655,119, alone or

in combination with Crowell, U.S. Patent No. 4,592,573.

Clearly, as discussed with respect to Issue 2, above, Thompson does not anticipate claim 1, and cannot serve, by itself, as a reference for obviousness-type rejection, since Thompson fails to teach, mention, or suggestion all but arguably a single element of claim 1. Thompson fails to teach, mention, or suggest a rectangular, single-sheet entity of any kind, let alone a rectangular, single-sheet registration form and key packet. Thompson fails to teach, mention, or suggest two components separable via perforations, and a key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps.

In section 5 of the Most Recent Office Action, the Examiner states:

Regarding claim 5, Thompson discloses the envelope being rectangular (as seen in figure 1). Thompson further discloses that the registration form comprises the top portion of the registration form and key packet and the registration form is separated from the unfolded key packet by a horizontal line of perforations (viewing the envelope in figure 1 at a ninety degree angle would provide the horizontal line of perforations separating the top portion having the form from the bottom portion having the key packet). Thompson discloses the claimed invention except for the registration form and key packet having a greater vertical dimension than a horizontal dimension. It would have been an obvious matter of design choice to provide any desired dimensions for the registration form and key packet, since modification would have involved a mere change in the size of the component ...

Claim 1, from which claims 2 and 5 depend, clearly claims a rectangular single-sheet registration form and key packet that includes a registration form and an *unfolded* key packet. The Examiner seems to be claiming that, when Thompson's ticket envelope is fully assembled, it is rectangular. That is, in fact, the case, but by then it is not a single sheet – containing a glassine material bonded to the rear panel. Moreover, it is obviously not unfolded at that point. Thompson not once illustrates, mentions, or suggests perforations. As with the Examiner's anticipation rejection, the obviousness-type rejection of claims 2 and 5 makes little sense, and is entirely inconsistent with what Thompson actually discloses.

In rejecting claims 3, 4, 11, 13-16, and 18-20 in section 6 of the Most Recent Office Action, the Examiner combines Crowell with Thompson, stating that:

Crowell discloses a foldable sheet (30) that can be printed on by a computer printer (to, inherently, include laser printers) (see col. 2, lines 45-51). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Thompson's invention to include pre-printing information on the envelope with advertising indicia and other related information to convey information to the

user of the envelope.

In fact, Crowell merely states that "[a]nother object of the invention is to provide a foldable card or sheet which is conveniently inserted in and types upon by a typewriter or computer printer and then quickly decorated with a separate pop-up three-dimensional message-bearing insert adhesively secured to the card or sheet along an internal fold line" (column 2, lines 46-51). In essence, Crowell indicates that is an object of Crowell's invention that a card or sheet be first imprinted and an insert then adhesively affixed to it. Crowell's alternative embodiments include non-rectangular sheets and sheets with dye-cut pop-outs, but the only embodiment deemed potentially suitable for printing by Crowell is a card or sheet without the dye-cut pop-outs. Crowell never mentions this invention object again, and thus it remains a stated goal, rather than an affirmative statement of whether or not the goal is met, or by what considerations the goal may be deemed to have been met. Printing or typing a sheet of paper is quite well known in the prior art. Crowell adds nothing more than printing or typing a sheet of paper.

Crowell also completely fails to add the many elements of independent claims 1, 11, and 16 that Thompson fails to teach, mention, or suggest. A combination of Crowell and Thompson, although not suggested in the prior art, nor reasonably suggested by any explicit or implicit consideration, since Crowell and Thompson are directed to completely unrelated inventions, still does not produce "[a] rectangular, single-sheet registration form and key packet comprising: a registration form; an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps; and one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet. Neither Crowell nor Thompson disclose a registration form, perforations, and an unfolded key packet that can be quickly and accurately folded into a complete key packet in two or fewer steps.

An important point to note is that Applicants specifically claim, in independent claims 11 and 16, "[a] single-sheet registration form and key packet comprising: a single sheet dimensioned to feed through a commercially available computer printer" and "[a] single-sheet registration form and key packet comprising: a single sheet having dimensions, a weight, a texture, and a moisture content that allows the single sheet to be

reliably fed through a commercially available computer laser printer," respectively. These are not trivial elements. Applicant has submitted a Declaration and evidence, in the Amendment filed July 17, 2003, of the great care, effort, and technical consideration involved in producing a single-sheet registration form and key packet that is compatible with commercial printers, specifically laser printers. The Examiner has failed to take note of that submitted Declaration and evidence. As noted in *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972), "[a]s a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." Particularly at the time that the current application was filed, feeding of non-rectangular sheets of paper through laser printers was, at best, problematic. Applicant's representative experienced many jams and feeding problems related simply to using rectangular A4 paper in one tray, and regular sized paper in another tray in laser printers in law firms. Applicant's representative believes that, in view of the submitted evidence, the Examiner is not in a position to conclude or infer that a particular, non-rectangular sheet disclosed in Thompson or any other reference can be reliably printed in a commercial printer.

CONCLUSION

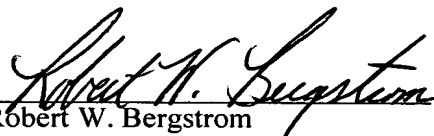
Applicant's claimed invention is clearly neither anticipated nor made obvious by Thompson, Crowell, or Thompson and Crowell in combination. There is no explicit or implicit suggestion for the combination, and the combination fails to teach, mention, or suggest a majority of the claim elements of independent claims 1, 11, and 16, and the claims that depend from them.

Applicant respectfully submits that all statutory requirements are met and that the present application is allowable over all the references of record. Therefore, Applicant respectfully requests that the current application be passed to issue.

Applicant's representative particularly stresses that the current application should be passed to issue. Prosecution of the current application has continued for over four years, and has involved six different Office Actions, three Responses, and four Amendments. Thompson first appeared in the second Office Action, and Thompson and many other references have been alternatively dropped and subsequently again included in numerous rejections. The Examiner has failed to respond to a great deal of submitted evidence, and has

failed in six attempts to offer a credible rejection. Applicant is not a large corporation or wealthy, serial inventor. He developed his invention over a period of many years, and has single-handedly brought it to market and developed a successful business, now threatened by infringers and infringement-minded customers. He is exactly the type of individual whom the patent system was originally intended to protect by providing a window of time in which to exploit the invention that he has labored over and brought to market. It is ironic and tragic that an individual inventor needs to spend four years and a great deal of money to prosecute a relatively straightforward invention, all the while watching the fruits of his creative endeavors slip away, failed by the very system originally devised to protect him.

Respectfully submitted,
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APPENDIX I

1. A rectangular, single-sheet registration form and key packet comprising:
 - 5 a registration form;
an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps; and
 - 10 one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.
2. The single-sheet registration form and key packet of claim 1 wherein the single-sheet registration form and key packet is pre-printed with textual and graphical information.
- 15 3. The single-sheet registration form and key packet of claim 1 wherein the single-sheet registration form and key packet is printed on a printing device to contain textual and graphical information.
- 20 4. The single-sheet registration form and key packet of claim 1 wherein the single-sheet registration form and key packet is pre-printed with textual and graphical information and wherein the single-sheet registration form and key packet is printed on a printing device to contain additional textual and graphical information.
- 25 5. The single-sheet registration form and key packet of claim 1 wherein the single-sheet registration form and key packet is rectangular and has a greater vertical dimension than a horizontal dimension, wherein the registration form comprises the top portion of the single-sheet registration form, and wherein the registration form is separated from the unfolded key packet by a horizontal line of perforations.
- 30 6. The single-sheet registration form and key packet of claim 5 wherein the single-sheet registration form and key packet is bisected by a vertical line of perforations, wherein a lower tab of the unfolded key packet is separated from a central portion of the unfolded key packet by a second horizontal line of perforations, and wherein the complete key packet is formed by

folding the unfolded key packet first about the second horizontal line of perforations and then about the vertical line of perforations.

7. The single-sheet registration form and key packet of claim 1 wherein the keys are selected from a group consisting of metal keys and magnetic key cards.

11. A single-sheet registration form and key packet comprising:

a single sheet dimensioned to feed through a commercially available computer printer, the single sheet including

a registration form,
an unfolded key packet separated the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps, and

one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

12. The single-sheet registration form and key packet of claim 11 wherein the single sheet is a single sheet selected from one of the following materials:

- paper;
- a fibrous material;
- a polymeric material;
- a cohesive film of natural fibers and filler;
- a cohesive film of artificial fibers and filler;
- a cohesive film of both natural and artificial fibers and filler;
- a plastic film.

13. The single-sheet registration form and key packet of claim 11 wherein the single-sheet registration form and key packet is pre-printed with textual and graphical information.

14. The single-sheet registration form and key packet of claim 11 wherein the

single-sheet registration form and key packet is printed on the computer printer to contain textual and graphical information.

15. The single-sheet registration form and key packet of claim 11 wherein the
5 single-sheet registration form and key packet is pre-printed with textual and graphical information is printed on the computer printer to contain additional textual and graphical information.

16. A single-sheet registration form and key packet comprising:

10 a single sheet having dimensions, a weight, a texture, and a moisture content that allows the single sheet to be reliably fed through a commercially available computer laser printer, the single sheet including

a registration form,

an unfolded key packet separated from the registration
15 form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be accurately folded into a complete key packet in two or fewer steps, and

one or more die-cut slots in the unfolded key packet
which serve as a slot or slots to hold a number of keys in the complete key
20 packet.

17. The single-sheet registration form and key packet of claim 16 wherein the single sheet is a single sheet selected from one of the following materials:

paper;

25 a fibrous material;

a polymeric material;

a cohesive film of natural fibers and filler;

a cohesive film of artificial fibers and filler;

a cohesive film of both natural and artificial fibers and filler;

30 a plastic film.

18. The single-sheet registration form and key packet of claim 16 wherein the single-sheet registration form and key packet is pre-printed with textual and

graphical information.

19. The single-sheet registration form and key packet of claim 16 wherein the single-sheet registration form and key packet is printed on the computer
5 printer to contain textual and graphical information.

20. The single-sheet registration form and key packet of claim 16 wherein the single-sheet registration form and key packet is pre-printed with textual and graphical information is printed on the computer laser printer to contain
10 additional textual and graphical information.

21. The single-sheet registration form and key packet of claim 16 wherein the single-sheet is rectangular.